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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,154	12/29/2000	Scott M. Frank	BS00-086	7629

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,154	FRANK ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 10-16 and 35-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 10-16 and 35-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20050916</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 11/18/2005 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/750,154 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claims 1, 5-9, 17-34 have been cancelled and Claims 35-54 have been added; therefore Claims 2-4, 10-16, and 35-54 are currently pending in application 09/750,154.

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 11, 35, 41, and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**
5. **Independent Claims 11 and 48** describe a utilization system which determines how the intellectual property asset should be utilized based upon intellectual property licensing

rights marketability data, wherein the determining includes determining: a market potential assessment, a marketing project timeframe assessment, a projected revenue potential assessment, a competitive threat assessment, and a marketing opportunity assessment. However, the specification does not describe generating/determining such a marketing assessment as part of the IP Utilization System (Utilization based on initial valuation of IP asset – objective and subjective standards, pg.48 of specification), but rather describes generating/determining such a marketing assessment as part of the IP Marketing System (Fig.212; pg.63 of Specification, IP marketing opportunity scoring module) - which is used once the decision to “Market” is made by the Utilization System (Fig.5). The applicant has combined the two separate systems (IP Utilization System [7000] and IP Marketing System [9000]) in the independent claims, to create one all-encompassing system, which is not fully disclosed or described in the specification.

12. **Independent Claims 35 and 41** describe a utilization system which determines how the intellectual property asset should be utilized based upon intellectual property licensing rights marketability data, wherein the determining includes generating an intellectual property licensing rights marketing opportunity score. However, the specification does not describe generating a marketing opportunity score as part of the IP Utilization System (Utilization based on initial valuation of IP asset – objective and subjective standards, pg.48 of specification), but rather describes generating a marketing opportunity score as part of the IP Marketing System (Fig.212; pg.63 of Specification, IP marketing opportunity scoring module) - which is used once the decision to “Market” is made by the Utilization System (Fig.5). The applicant has combined the two separate systems (IP

Utilization System [7000] and IP Marketing System [9000]) in the independent claims, to create one all-encompassing system, which is not fully disclosed or described in the specification.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 11-13 and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al. (US 6,298,327 B1).

21. As per **independent Claims 11 and 48**, Hunter discloses a method (computer readable medium) for determining whether to market licensing rights for an intellectual property asset, the method comprising: receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets (inventive disclosure), wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception); storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual

property asset protection data records (Fig.2), wherein each intellectual property asset protection data records of the plurality of intellectual property asset protection data records in the intellectual property asset protection database corresponds to at least one intellectual property asset; providing intellectual property asset protection data from at least one intellectual property asset protection data record in the intellectual property utilization system; and determining, utilizing a computer system of the intellectual property utilization system, a utilization recommendation based on intellectual property licensing rights marketability data (C9 L15-17; C2 L43-54, C5 L39-44, C8 L11-17, Determine whether to Patent (US, EPO, JPO) the technology (utilization of inventive disclosure) or not based on a patentability assessment and marketability evaluation).

22. As per Claims 12 and 49, Hunter discloses determining an intangible value assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset, wherein the marketing opportunity assessment corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database for licensing rights for the intellectual property asset is further based at least in part on the determined intangible value assessment (Evaluation of Market Value, C8 L11-17).

23. As per Claims 13 and 50, Hunter discloses determining that licensing rights for the intellectual property asset are to be marketed when the marketing opportunity assessment satisfies a predetermined threshold (C2, C8, worth the investment).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 2-4 and 35-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter.

26. As per **independent Claims 35 and 41**, Hunter discloses a computer-readable medium containing a program for use in a computer for determining whether to market licensing rights for an intellectual property asset, the program comprising the steps of: receiving intellectual property asset protection data, wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets (inventive disclosure), wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception); storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (Fig.2), wherein each intellectual property asset protection data records of the plurality of intellectual property asset protection data records in the intellectual property asset

protection database corresponds to at least one intellectual property asset; providing intellectual property asset protection data from at least one intellectual property asset protection data record in the intellectual property utilization system; and determining by the intellectual property utilization system a utilization recommendation based upon intellectual property licensing rights marketability data (C9 L15-17), wherein the determining includes generating an assessment of the marketability of licensing rights for at least one intellectual property asset corresponding to the at least one intellectual property asset protection data record from the intellectual property asset protection database, including determining an intellectual property licensing rights marketing opportunity score (Marketability Assessment), based at least in part on the intellectual property asset protection data and on a criterion, wherein the determining of the intellectual property licensing rights marketing opportunity score includes a comparative analysis of information from a database of historical data regarding valuations of at least one other intellectual property asset (C2 L43-54, C5 L39-44, C8 L11-17, Determine whether to Patent (US, EPO, JPO) the technology (utilization of inventive disclosure) or not based on a patentability assessment and marketability evaluation; Evaluation of Market Value, C8 L11-17).

27. While Hunter does not explicitly disclose wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will have a non-royalty impact on a marketer of the licensing rights of the intellectual property asset, Official Notice is taken that marketing analysis of Intellectual Property was well known at the time the invention was made, to include the assessment

between obtaining intellectual property protection and maintaining the intellectual property as an in-house trade secret (Coca-Cola's maintenance of soda formulations as Trade Secrets – decision determined by analyzing long-term impact of releasing formulas to public).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will have a non-royalty impact on a marketer of the licensing rights of the intellectual property asset, in the system disclosed by Hunter, for the advantage of providing a system/program for determining whether to market an intellectual property (licensing rights), with the ability to increase the effectiveness of the system by incorporating a variety of business assessments (criterion) - in order to ensure the right decision is made.
29. As per Claim 2, Hunter discloses generating a marketing recommendation based at least in part on the generated assessment.
30. As per Claim 3, Hunter discloses wherein the marketing recommendation is an absolute recommendation based at least in part on a predetermined threshold.
31. As per Claim 4, Hunter discloses wherein the marketing recommendation is a relative recommendation based at least in part on a comparison of the generated assessment with one or more assessments of the marketability of the licensing rights of other intellectual property assets.
32. As per Claims 36-38 and 42-45, Hunter discloses generating an assessment of the marketability of the intellectual property asset based at least in part on the intellectual

property asset and on a criterion (C3 L1-26), and while Hunter fails to expressly disclose wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will give the customer a competitive advantage over the marketer of the licensing rights of the intellectual property asset, wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will increase a potential for future commercially advantageous transactions by the marketer of the licensing rights with the customer, wherein the criterion includes whether marketing the licensing rights of the intellectual property asset to a licensing rights customer will foster internal organization relations, and/or wherein the criterion includes a protection status associated with the intellectual property asset, Official Notice is taken that intellectual property marketing/business assessments were well known at the time the invention was made, to include the assessment techniques/criteria disclosed in claims 36-38 and 42-45.

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the criterion includes whether marketing the intellectual property asset to a customer will give the customer a competitive advantage over the marketer of the intellectual property asset, wherein the criterion includes whether marketing the intellectual property asset to a customer will increase a potential for future commercially advantageous transactions by the marketer with the customer, wherein the criterion includes whether marketing the intellectual property asset to a customer will foster internal organization relations, and/or wherein the criterion includes a protection status associated with the intellectual property asset, in the system

disclosed by Hunter, for the advantage of providing a system/program for determining whether to market an intellectual property (licensing rights), with the ability to increase the effectiveness of the system by incorporating a variety of business assessments (criterion) - in order to ensure the right decision is made.

34. As per Claims 39 and 46, Hunter discloses determining that the licensing rights of the intellectual property asset are to be marketed when the generated assessment satisfies a predetermined threshold (C8, worth the investment of obtaining protection).

35. As per Claims 40 and 47, Hunter discloses determining that the licensing rights of the intellectual property asset is to be marketed based at least in part on a comparison of the generated assessment with one or more assessments of the marketability of licensing rights of other intellectual property assets.

36. Claim 10, 14-16, and 51-54 are rejected under 35 U.S.C. 103 as being unpatentable over Hunter.

37. As per Claims 10 and 54, Hunter does not expressly show wherein the criterion is selected from a marketing viability criterion, a potential customer criterion, a competitive criterion, a market potential criterion, a development criterion, an ownership criterion, a patent status criterion, an interest customer criterion, a deal complexity criterion, a time to closing criterion, a competitive advantage criterion, a future deals criterion, a customer relationship criterion, an internal political criterion, and a public relations criterion.

38. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be

performed regardless of the type of criterion used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

39. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a criterion selected from a marketing viability criterion, a potential customer criterion, a competitive criterion, a market potential criterion, a development criterion, an ownership criterion, a patent status criterion, an interest customer criterion, a deal complexity criterion, a time to closing criterion, a competitive advantage criterion, a future deals criterion, a customer relationship criterion, an internal political criterion, and a public relations criterion, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
40. As per Claims 14-16 and 51-53, Hunter does not expressly show wherein determining a marketing potential assessment step further includes determining a product viability assessment, a product marketing readiness assessment, and/or a projected total anticipated revenue assessment.
41. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method (system, computer-readable medium) for determining whether to market an intellectual property asset would be performed regardless of the type of marketing assessment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

42. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a variety of industry common marketing assessments, to include: a product viability assessment, a product marketing readiness assessment, and/or a projected total anticipated revenue assessment, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention

Response to Arguments

43. Applicant's arguments filed 11/18/05 have been considered, but are moot in view of the new ground(s) of rejection.

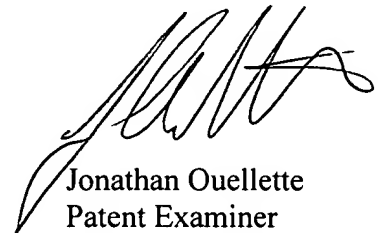
Conclusion

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

Art Unit: 3629

46. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

January 23, 2006



Jonathan Ouellette
Patent Examiner
Technology Center 3600